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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,538	09/28/1999	RICHARD ALAN DIEDRICH	RO999114	2884

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EXAMINER

SHAH, SANJIV

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/407,538

Applicant(s)

DIEDRICH ET AL

Examiner

Sanjiv D. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for continued examination filed on 5/12/2005
2. Claims 1-42 are pending in the case. Claims 1, 19, 27, 35, and 38 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al. (USPN 6,526,424 B2 - filed on 03/1998) in view of Anupam et al. (USPN 6,535, 912 131 - filed 08/1999).

Regarding independent claim 1, Kanno discloses: A method of verifying a bookmark, comprising the steps:

(a) storing, as a bookmark in at least a first data structure, first network information address of a document having content (on col. 2, lines 36-41: teaches registering the URL of a desired page as one element of the bookmark data);

(b) identifying embedded network information addresses within the content (on col. 19, line 65- col. 20, line 46: teaches determining URLs are between the tags within a HTML file or page (the URLs are hidden in the HTML page));

(c) automatically searching, at a predefined frequency, for the document located at the first network information address to determine whether the first network information address is retrievable; and wherein if the first network information address is retrievable (on col. 1, line 66- col. 6, line 13 and col. 19, line 65 - col. 20, line 25: teaches automatic traveling through pages and automatically accessing a page of an address designated by address information of a page included in each record of

bookmark information; determining by automatic traveling of addresses URLs have been changed);

(d) determining whether the document has been moved to a second network information address different from the first network information address (on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches by automatic traveling can determine if URLs have been changed or updated by locating within an HTML file a predetermined hidden tag at the old address (URL). The hidden tag can represent the new URL to relocate or access the updated page); and -

(e) wherein if the first network information address is not retrievable (on col. 19, line 65- col. 20, line 46: teaches the URL between tags within the HTML file can also not be changed or updated; the user can still use the stored valid URL as a bookmark). However, Kanno does not explicitly "making the identified embedded network information addresses available to a user via the stored bookmark".

Anupam discloses a smart bookmark that retrieves stored traversal links related to the bookmarked requested web page (see col. 2, lines 51-66, col. 4, lines 45-55, and col. 9, line 26- col. 10, line 64).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anupam into Kanno to provide a way to retrieve stored traversal links from the smart bookmarked requested web page, as taught by Anupam, incorporated into the book marking system of Kanno, in order for users to quickly visit his favorite pages in a WWW environment.

Regarding dependent claims 2 and 28, Kanno discloses:

wherein the first network information address is a Uniform Resource Locator (URL) (Kanno on col. 19, line 65 - col. 20, line 25: teaches addresses are URLs).

Regarding dependent claims 3, 22, and 29, Kanno discloses:

wherein the document located are the first network information address is a Hypertext Markup Language (HTML) document (Kanno on col. 19, line 65 - col. 20, line 25: teaches web site of pages in HTML).

Regarding dependent claims 4 and 20, Kanno discloses a user-defined frequency (Kanno on col. 5, line 66- col. 6, line 13: teaches address information of a page included in each record of bookmark information stored in storing unit at a predetermined time information and obtaining change information).

Regarding dependent claims 5, 8, and 16, Kanno discloses: wherein if the document has been moved or has not been moved to the second network information address, replacing the first network information address in the first data structure with the second network information address (Kanno on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches by automatic traveling can determine if URLs have been changed or updated by locating within an HTML file a predetermined hidden tag at the old

address (URL). The hidden tag can represent the new URL to relocate or access the updated page, in other words, the old URL is replaced with a new URL).

Regarding dependent claims 6 and 10, Kanno discloses:

wherein determining whether the information has been moved to the second network information address comprises detecting only a single hypertext link in a forwarding document located at the first network information address (Kanno on col. 19, line 25 - col. 20, line 25: teaches automatic traveling unit searches for hidden tags of an HTML file to retrieve new URL).

Regarding dependent claims 7, 9, 18., 26, and 30, Kanno discloses:

determining whether the document has changed comprising comparing a stored first date to a second date returned by a server (Kanno on col. 19, line 65 - col. 20, line 25 teaches determining a change in data and time by comparing with bookmark information containing old-data and-time):

Regarding dependent claims 11-12 and 14, Anupam discloses:

storing each identified embedded network information address in a second data structure containing one or more second data fields which relate to the embedded network information addresses (Anupam on col. 2, lines 51-66, col. 4, lines 45-55, and col. 9, line 26- col. 10, line 64 teaches stored traversal links related to the bookmarked requested web page).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anupam into Kanno to provide a way to retrieve stored traversal links from the smart bookmarked requested web page, as taught by Anupam, incorporated into the book marking system of Kanno, in order for users to quickly visit his favorite pages in a WWW environment.

Regarding dependent claim 15, Kanno discloses:

attempting to download the information located at first network information address, wherein a successful attempt indicates that the first network information address is retrievable and an unsuccessful attempt indicates that the first network information address is irretrievable (Kanno on col. 19, line 65 - col. 20, line 25: teaches determining if addresses (URLs) have been changed; a relevant page cannot be found due to a change of address).

Regarding dependent claim 17, Kanno discloses:

the first network information address is retrievable, determining whether the document has changed (Kanno on col. 19, line 65 - col. 20, line 25: teaches determining if-addresses (1;TRLs)-have -been changed

Regarding independent claim 19, Kanno discloses:

A computer implemented automated method for maintaining bookmarks, comprising:

(a) storing, in a data structure, a bookmark to a network information address of a document having content (Kanno on col. 2, lines 36-41: teaches registering the URL of a desired page as one element of the bookmark data);

(b) scanning the content for one; or more embedded network information addresses, wherein if any embedded network information addresses are found, storing the embedded network information addresses (Kanno on col. 1, line 66- col. 6, line 13 and col. 19, line 65 - col. 20, line 25: teaches automatic traveling through pages and automatically accessing a page of an address designated by address information of a page included in each record of bookmark information; determining by automatic traveling of addresses URLs have been changed); and

(c) periodically determining whether the network information address has changed and; wherein if the network information address has changed: determining whether a forwarding network information address is provided; and (Kanno on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches by automatic traveling can determine if URLs have been changed or updated by locating within an HTML file a predetermined hidden tag at the old address (URL). The hidden tag can represent the new URL to relocate (forwarding address) or access the updated page)

However, Kanno does not explicitly "associating the bookmark with the embedded network information addresses".

Anupam discloses a smart bookmark that retrieves stored traversal links related to the bookmarked requested web page-(see col-. 2, lines 51-66; col. 4; lines 45=55; and col 9, line 26- col. 10, line 64).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anupam into Kanno to provide a way to retrieve stored traversal links from the smart bookmarked requested web page, as taught by Anupam, incorporated into the book marking system of Kanno, in order for users to quickly visit his favorite pages in a WWW environment.

Regarding dependent claim 21, Kanno discloses:

wherein periodically determining whether the bookmark network information address has changed comprises attempting to download the document (Kanno on col. 2, lines 1-15: teaches download of relevant data and on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: attempting to access a page).

Regarding dependent claim 23, Kanno discloses: wherein periodically determining whether the network information address has changed comprises loading the network information address from the data structure and attempting to locate the document on a server, wherein a successful attempt indicates that the network information address has not changed and an unsuccessful attempt indicates that the network information address has changed (Kanno on col. 19, line 65 - col. 20, line 25: teaches automatic traveling unit travels pages to determine if addresses thereof have been changed; a page cannot be found due to a change in address. When the automatic traveling unit receives the tag "relocate", it accesses the address (URL) represented by "REURL" obtains title .and URL to update the record of the bookmark data file).

Regarding dependent claim 24; Kanno discloses that the network information address has changed, and if the forwarding to the network information address is provided, replacing the network information address in the data structure with a bookmark to the forwarding network information address (on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches determine if URLs have been changed or updated by locating within an HTML file a predetermined hidden tag at the old address (URL). The hidden tag can represent the new URL to relocate (forwarding network information address) or access the updated page, in other words, the new URL replaces the old URL).

Regarding dependent claim 25, Kanno discloses:

that the bookmark network information address has not changed, determining whether the content has changed (Kanno on col. 19, line 65 - col. 20, line 25: teaches determining if addresses (URLs) have been changed).

Regarding independent claim 27, Kanno discloses:

A signal bearing medium for storing a program that when executed by a computer performs a operation comprising:

(a) downloading a bookmark network information address of a document having content (Kanno on col. 5, line 66 - col. 6, line 13: teaches managing bookmark information and obtaining change information of a page);

(b) storing the bookmark network information address in a data structure (Kanno on col. 2, lines 36-41: teaches registering the URL of a desired page as one element of the bookmark data);

(c) scanning-the content-for brie or more embedded-network information addresses, wherein if any embedded network information addresses are found, storing the embedded network information addresses in the data structure; and

(d) periodically determining whether the information is retrievable at the bookmark network information address (Kanno on col. 1, line 66- col. 6, line 13 and col. 19, line 65 - col. 20, line 25: teaches automatic traveling through pages and automatically accessing a page of an address designated by address information of a page included in each record of bookmark information; determining by automatic traveling of addresses URLs have been changed), wherein:

(i) if the information is not retrievable at the bookmark network information address, determining whether a forwarding network information address is provided, wherein if the forwarding network information address is provided, replacing the bookmark network information address in the data structure with the forwarding network information address, and wherein if a forwarding network information address is not provided (Kanno on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches automatic traveling unit travels pages to determine if addresses thereof have been changed; a page cannot be found due to a change in address. When the automatic traveling unit receives the tag "relocate", it accesses the address (URL) represented by

"REURL" obtains title and URL to update the record of the bookmark data file; an HTML file has a predetermined hidden tag representing the new URL to relocate or access the updated page, in other words, the new URL replaces the old URL);

(ii) if the information is retrievable at the bookmark network information address, determining -whether the information has changed, wherein if the-information has changed, repeating (c) (Kanno on col. 19, line 65 - col. 20, line 25: teaches the URL has changed to a new URL).

However, Kanno does not explicitly "generating a backup document containing the embedded network information addresses stored in the data structure (bookmark)"

Anupam discloses a smart bookmark that retrieves stored traversal links related to the bookmarked requested web page (see col. 2, lines 51-66, col. 4, lines 45-55, and col, 9, line 26- col. 10, line 64).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anupam into Kanno to provide a way to retrieve stored traversal links from the smart bookmarked requested web page, as taught by Anupam, incorporated into the book marking system of Kanno, in order for users to quickly visit his favorite pages in a WWW environment.

Regarding dependent claims 31-33, Kanno discloses:

wherein the bookmark network information address identifies a server computer connected to a client computer, and wherein the program is located on the client computer herein the client computer; the server computer are the same computer

system; the client computer and the server computer comprise different computer systems connected by a network (Kanno on col. 19, lines 7-31: teaches URL used to locate the WWW server which is in communication with the WWW browser).

Regarding dependent claim 34, Kanno discloses:

wherein the data structure is stored on the client computer (Kanno on col. 21, lines 16-65: teaches stored content or address of a page).

Regarding independent claim-35,-Kanno discloses:

A computer implemented method of managing bookmarks, comprising:

(a) in response to a user request: to bookmark a web page: storing a network address for the web page in a bookmark data structure; storing each hypertext link embedded in the web page in the bookmark data structure in a manner which associates the embedded hypertext links and the web page (Kanno on col. 2, lines 36-41 and col. 3, lines 1-12: teaches registering (adding) the URL of a desired page or performing "net surfing" as one element of the bookmark data); and associating a graphical bookmark object of a bookmark menu with the web page (on col. 10, lines 12-67: teaches bookmark display screen composed of a menu portion); and

(b) determining whether the web page has moved to a different network address; (c) if the web page has moved, determining whether an updated network address for the web page can be located; and (d) if the updated network address cannot be located (Kanno on col. 19, line 65 - col. 20, line 25 and col. 21, lines 16-65: teaches automatic traveling

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unit travels pages to determine if addresses thereof have been changed; a page cannot be found due to a change in address. When the automatic traveling unit receives the tag "relocate", it accesses the address (URL) represented by "REURL" obtains title and URL to update the record of the bookmark data file; an HTML file has a predetermined hidden tag representing the new URL to relocate or access the updated page, in other words, the new URL replaces the old URL).

However, Kanno does not explicitly "associating the graphical bookmark object with the stored embedded hypertext links of the web page". Anupam discloses a smart bookmark that retrieves stored traversal links related to the bookmarked requested web page (see col. 2, lines 51-66, col. 4; lines 45-55; and col. 9, line 26- col. 10, line 64). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anupam into Kanno to provide a way to retrieve stored traversal links from the smart bookmarked requested web page, as taught by Anupam, incorporated into the book marking system of Kanno, in order for users to quickly visit his favorite pages in a WWW environment.

Regarding dependent claim 36, Kanno discloses:

wherein (b) is performed at a predefined frequency (Kanno on col. 5, line 66- col. 6, line 13: teaches address information of a page included in each record of bookmark information stored in storing unit at a predetermined time information and obtaining change information).

Regarding dependent claim 37, Kanno discloses:

displaying the stored embedded hypertext links of the web page upon a user selection of the graphical bookmark object (Kanno on col. 10, lines 12-67: teaches display page accessed and retrieved by selection of a registered bookmark image or icon).

Regarding claims 38-42, the limitations of claims 38-42 incorporates substantially similar subject matter as in claims 1-37, and are rejected under the same rationale.

Response to Arguments

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Anupam et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

A general allegation that the invention was completed prior to the date of reference is not sufficient. *Ex parte Saunders*, 1883 C. D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was

conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and thus does not satisfy the requirements of 37 CFR 1.131 (b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F. 2d at 718-719, 184 USPQ at 33. See also IN re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

The declaration and the accompanying exhibit do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore does not support conception of the claimed invention. For example, Exhibits is silence about implementation or existence of prototype or product. Therefore it could have been mere idea and is not a complete disclosure of the claimed invention. Applicants have failed to map the claimed limitations with the exhibits.. Applicant has not shown that the CLAIMED invention as encompassed in instant claims existed prior to the filing date of

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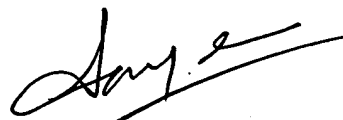
Anupam et al. Therefore the affidavit is treated as a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion. It is not clear that applicant had complete invention at the time the exhibits were exchanged as claimed by declaration. Also the exhibits, specifically fails to show completed invention being implemented at the time as claimed. The invention could have been implemented in various versions and it is unclear if final version was implemented at the time. Therefore applicant's arguments and declaration fails to present the facts that the invention was complete and that all claimed limitation were taught by exhibits. Therefore the rejection is proper.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah

Primary Examiner

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S. Shah

May 30, 2004